

REMARKS

The Official Action of November 30, 2009 has been carefully reviewed. Reconsideration of the application in view of the above amendments and the following remarks is respectfully requested.

No claims have been amended. The claims under consideration are Claims 30A, 30B, 33-48. Applicants sincerely apologize for the typographical error in incorrectly numbering the claims in their Preliminary Amendment of August 24, 2006. Applicants gratefully acknowledge that the first claim 30 is now designated Claim 30A and that the second claim 30 is now designated Claim 30B. Applicants will amend the numbering of the claims and the claim dependencies to correct this typographical error as prosecution of the application progresses.

1. Restriction Requirement

Under 35 U.S.C. 121 and 372, the Examiner required restriction among:

- I. Group I, Claims 30A, 30B, 31-47 drawn to compounds and compositions having a cyclohepta[c]pyridine core where both X and Y are carbon and n is 1;
- II. Group II, Claims 30A, 30B, 31-47 drawn to compounds and compositions having a cyclohexa[c]pyridine core where X is carbon and n is 0;
- III. Group III, Claims 30A, 30B, 31-47 drawn to compounds and compositions having an 5H-pyrido[4,3-c]azepine core where X is carbon and Y is nitrogen n is 1 or a pyrido[4,3-b]azepine core where Y is carbon and X is nitrogen n is 1;
- IV. Group IV, Claims 30A, 30B, 31-47 drawn to compounds and compositions having other values of X or Y, drawn to for example a tetrahydro-naphthyridine core where X is nitrogen n is 0; and
- V. Group VIII, Claim 48, drawn to methods of treating various disorders, where each one of the compounds of groups I-IV has a corresponding method group, paired respectively.

In response to this requirement, the Applicants hereby elect Group II, Claims 30A, 30B, 31-47, drawn to compounds and pharmaceutical compositions of Formula I, having a cyclohexa[c]pyridine core wherein X is carbon and n is 0, with traverse.

The claims reading on this group are Claims 30A, 30B, 31-43, and 45-47.

Applicants note that the claimed compounds possess a core structure wherein the central piperidinyl or piperazinyl ring bears an aryl group and a -CH₂-cycloalkyl aryl group. Accordingly, the compounds of the present invention possess a special technical feature and unity of invention.

Under 35 U.S.C. 121, the Examiner further requested provisional election of a single species for purposes of search.

In response to this requirement, Applicants hereby elect with traverse the compound:

(6R,8S)-6-[(3R,4R)-4-(2-chloro-4-fluorophenyl)-3-hydroxypiperidin-1-ylmethyl]-5,6,7,8-tetrahydroquinolin-8-ol,

which is listed as the 5th compound of Claim 46;

which is depicted in Table 2, page 17, Compound No. "33";

which is the title compound of Example 33, page 85, lines 20-34;

and wherein the elected claims reading on this elected compound are Claims 30A, 30B, 31, 33, 34, 36, 38, 39, 41, 42, 43, 45 and 46.

Applicants respectfully traverse this requirement and submit that the claimed compounds possess a common structural core that is essential to the activity of the compounds such that unity of invention is present in accordance with PCT Rule 13.1 and 13.2. Applicants respectfully submit that unity of invention is present in accordance with PCT Rule 13.1 and 13.2 and that restriction among the species is inappropriate.

Serial No.: 10/590,585
Case No.: BY0038P
Page 4

This election is being taken without prejudice to the filing of a divisional application directed to the non-elected subject matter. In accordance with the third sentence of 35 U.S.C. § 121, a patent issuing from the instant application should not be a reference against a divisional application filed before the issuance of such patent.

Applicants respectfully contend that the application is allowable and a favorable response from the Examiner is earnestly solicited.

Respectfully submitted,

By /J. Eric Thies, Reg.# 35382/
J. Eric Thies
Reg. No. 35,382
Attorney for Applicant
MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065-0907
(732) 594-3904

Date: December 17, 2009